

**o/0922/23**

**THE TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. UK00003587255  
BY FUTURE (AWARDS AND QUALIFICATIONS) LIMITED**

**TO REGISTER**

**CERAD**

**AS A TRADE MARK IN CLASSES 09, 16 AND 41**

**AND**

**THE OPPOSITION THERETO UNDER NO. 425171  
BY QUALSAFE LIMITED**

## Background and pleadings

01. On 29 January 2021, Future (Awards and Qualifications) Limited ('the applicant') applied to register the following trade mark under application number UK UK00003587255 ('the application'):

### **CERAD**

02. The application was accepted and published in Trade Marks Journal number 2021/013 on 26 March 2021 in respect of the following goods and services:

Class 09: Electronic publications downloadable from the Internet, computer software, computer programs, instructional videos, CD ROMs and DVDs, all relating to the training of paramedic and ambulance personnel.

Class 16: Printed matter, printed publications, books, instructional and teaching material, workbooks, booklets, training aids, manuals, stationery, instructional and reference material, all relating to the training of paramedic and ambulance personnel.

Class 41: Education; training; publication of books, texts, journals and periodicals; arranging and conducting conferences and seminars; provision of correspondence courses; education, instruction and training provided on-line from a computer database or from the Internet; provision of lectures and seminars; all relating to the training of paramedic and ambulance personnel; information, advisory and consultancy services relating to the aforesaid services.

03. On 25 June 2021, following the submission of a Form TM7A extending the opposition period, the application was opposed by Quallsafe Limited ('the

opponent'). The opposition was brought under sections 3(1)(b), 3(1)(c) and 3(1)(d) of the Trade Marks Act 1994 ('the Act').

04. The opponent's pleadings claimed that the sign 'CERAD' constitutes a recognised acronym for the expression 'Certificate in Emergency Response Ambulance Driving', and that it has been adopted as such by trade bodies involved in the training of ambulance drivers and healthcare staff. Given the alleged use by third parties, the opponent claimed that the sign: (i) may serve in trade to designate the kind, intended purpose and other characteristics of the goods and services pursuant to section 3(1)(c); (ii) is devoid of any distinctive character pursuant to section 3(1)(b); and (iii) has become customary in the language and established practices of the trade pursuant to section 3(1)(d).
05. The applicant filed a counterstatement denying the claims made, after which both parties submitted evidence. This culminated in a decision being issued under reference BL O/561/22 on 30 June 2022 ('the original decision'). In that decision, Mr Arran Cooper ('the original hearing officer'), acting on behalf of the Registrar, found that the opposition failed in relation to the section 3(1)(d) ground, but succeeded on the section 3(1)(b) and (c) grounds. As a result, the application was refused for all of the goods and services claimed in classes 09, 16 and 41.
06. Following an appeal to the Appointed Person, Mr Phillip Johnson considered and rejected the original hearing officer's consideration of acquired distinctiveness as being material to the decision. As a consequence, in his decision issued on 06 November 2022 under reference BL O/969/22, Mr Johnson allowed the appeal and remitted the case back to the Registrar for reassessment. Given that the original hearing officer had previously rejected the section 3(1)(d) grounds, the Appointed Person made it clear in his decision that remittal back to the Registrar was solely for the purposes of making a fresh determination on the section 3(1)(b) and (c) grounds (and for the evidence submitted to be reconsidered in that context).

07. As was the case when considered by the original hearing officer, both parties requested a (second) hearing. This took place before me on 25 April 2023 by video conference. The opponent was represented by Ms Alaina Newnes under instruction from Sonder & Clay; the applicant was represented by Ms Victoria Jones under instruction from IP-Active.com Limited. Both parties filed skeleton arguments prior to the hearing.

### **Preliminary matters relating to the appeal and remittal**

08. During the course of the appeal, the applicant had sought to limit its specification to a narrower set of terms proper to Class 41 (whilst remaining within the scope of the original specification in that class), and withdrew the original claim to goods in Classes 09 and 16 in its entirety. Although the Registrar has not yet received any formal instruction from the applicant relating to these specification amendments, the matter was formalised via a supplementary order made by the Appointed Person and issued on 06 November 2022. The order specifies that the application be limited to the following services:

Class 41      Development of qualifications, standards, approval of training providers, quality assurance of training providers, awarding of certificates, assessment and certification services, all relating to the training of paramedics and ambulance personnel.

09. The order also established the parameters of the reassessment (see paragraph 06 above relating to the applicable absolute grounds for refusal), and instructed Quallsafe Limited to pay Future (Awards and Qualifications) Limited a contribution of £1000 towards its costs in respect of the appeal, to be considered in costs calculations for this second decision (addressed at paragraphs 46 to 48 below).
10. At the hearing, both parties confirmed their understanding that the contested application now seeks protection solely for the Class 41 terms presented at paragraph 08 above. All of the Class 09 and Class 16 terms originally claimed

by the applicant are deemed to have been removed from the application, and the determination which follows will relate to the Class 41 terms only. On behalf of the applicant, and with reference to the approach described and confirmed by Mr Richard Arnold QC (as he then was) in *m.d.e.m* (BL O/333/05)<sup>1</sup>, Ms Jones confirmed that a Form TM21B would be submitted on conclusion of the proceedings.

11. I interpret the revised specification as being a claim to seven distinct services, all of which are proper to Class 41. Those services are: (i) the development of qualifications; (ii) the provision of standards (I note that the claim as-drafted is for 'standards' *solus*, but I take this to mean the provision of a means or method for demonstrating a particular proficiency and/or level of achievement); (iii) the approval of training providers; (iv) providing quality assurance of training providers; (v) the awarding of certificates; (vi) the provision of assessment services; and (vii) the provision of certification services. All seven distinct services are further defined as being related to the training of paramedics and ambulance personnel (only).
12. The assessment which follows will be limited to considering the sign's suitability for acceptance against the criteria set out in sections 3(1)(b) and 3(1)(c) of the Act, when used in relation to the Class 41 specification presented at paragraph 08 above.

### **Opponent's evidence**

13. The opponent filed evidence-in-chief in the form of a witness statement of Mr Nigel Barraclough, who has been CEO of Qualsafe Limited since forming the company in May 2000. His statement explains that the company provides training courses, qualifications and awards to various professions in the healthcare sector, including activities specifically targeted towards regional ambulance trusts and related to emergency response driving. Mr Barraclough

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<sup>1</sup> At paragraph 46 of this decision, the Appointed Person confirmed that "...it is acceptable for an applicant to offer an amendment to the specification during the course of proceedings without making a formal application until they have been concluded".

claims that a qualification commonly referred to and described as the 'Level 3 Certificate in Emergency Response Ambulance Driving' is recognised as being one of the qualifications required for entry into the ambulance service, and states that both his own company and the applicant's company are involved in providing courses to this sector. Mr Barraclough does not state when this requirement was introduced, but he does claim that the accompanying exhibits show the sign 'CERAD' being used in trade as an acronym, that it is recognised within the industry as being a generic term, and that his and others' entitlement to provide 'Certificate in Emergency Response Ambulance Driving' courses deem it necessary that they should also be free to use the sign 'CERAD' in their course of trade.

14. Four of Mr Barraclough's ten exhibits are described as 'Role Descriptions' i.e. documents setting out the responsibilities of different professional roles within the ambulance driver/practitioner sector (sometimes referred to as 'job descriptions'). They appear to be taken from websites belonging to The Institute of Apprenticeships and The Institute for Apprenticeships & Technical Education, and set out *inter alia* the duties undertaken in the roles of 'Associate Ambulance Practitioner', 'Ambulance Support Worker (Emergency, Urgent and Non-Urgent)', and 'Paramedic' (see Exhibits NB1, NB2, NB6 and NB8). Three further exhibits are 'Assessment Plans' which complement the aforementioned 'Role Descriptions' by listing mandatory qualification requirements and timeframes for achieving entry into the profession (see Exhibits NB3, NB7 and NB9). Four of the aforementioned seven exhibits are dated only via discreet references to Crown Copyright, reflecting the fact that they appear to have been published through government-produced (or endorsed) online resources aimed at promoting training and apprenticeship opportunities. Two of the exhibits - NB4 and NB5 - are taken from the websites of the 'Association of Ambulance Chief Executives' and 'Skills for Health' and fail to show any use of the sign 'CERAD' or the longer expression, whilst the remaining exhibit - NB10 - presents seven examples of various unconnected third parties promoting their emergency response driver training activities.

15. The opponent's evidence-in-reply consists of a second witness statement of Mr Barraclough coupled with five additional exhibits. The statement itself makes no further claims as to the alleged descriptiveness and/or non-distinctiveness of the sign 'CERAD'. Instead, it seeks only to emphasise that ambulance driving courses provided by both the applicant and the opponent are substantively the same in terms of their content and duration etc. (a point made in direct response to claims made by the applicant in its own evidence), and to make the general submission that acronyms are commonly used in relation to medical training. In support of the first point, supplementary exhibits NB11 and NB12 are undated extracts from the website of The Office of Qualifications and Examinations Regulation ('Ofqual') listing details of Ambulance Driving Courses provided by the applicant. In support of the second point, exhibits NB13, NB14 and NB15 are extracts from websites of three unconnected medical training providers showing use of the expressions '*First Aid at Work (FAW)*', '*Emergency First Aid at Work (EFAW)*', and '*Certificate in Assessing Vocational Achievement (CAVA)*'. All five exhibits are either clearly undated or inconclusive as to date of publication, and none show (or are purported to show) use of the sign 'CERAD' to any extent.

### **Applicant's evidence**

16. The applicant filed evidence in the form of a witness statement of Mr Christopher Young, Director of the applicant company since its founding in 2005, along with eight exhibits. Mr Young explains that his company is a regulated 'awarding company' responsible for the design, development and awarding of vocational qualifications. He also states that his company was approached by the Ambulance Service in 2013 with a view to developing a regulated qualification for ambulance drivers. He claims that the 'Level 3 Certificate in Emergency Response Ambulance Driving' qualification was launched in 2015 and that, in his own words, "*the acronym 'CERAD' was soon being used by customers and within the field of ambulance driver training*". Data presented in the statement shows that UK learner registrations (i.e. subscriptions) for the 'CERAD' qualification rose from 1,197 in 2016 to 3,837

in September 2021, with the total value of UK registration fees over that six-year period being approximately £1.1million.

17. Of the eight exhibits submitted by the applicant, six seek to support Mr. Young's general narrative around how regulated awarding companies operate, how the 'Level 3 Certificate in Emergency Response Ambulance Driving' is a *bona fide* product that has been supported by ambulance services and is recognised and listed by regulating bodies such as Ofqual, and the extent to which different types of ambulance driving certificates are available to prospective trainees (exhibits CY1, CY2, CY3, CY4, CY6 and CY8 refer). These six exhibits do not show use of the sign 'CERAD' and do not seek to support any claims regarding the mark's distinctiveness, whether inherent or acquired through use. Rather, Mr Young presents them with the intention of demonstrating the freedom available to awarding organisations and training providers in terms of how to name and describe their particular products and standards. Of the remaining two exhibits, CY5 - which consists of website excerpts from eight different training providers - shows third party usage of the sign 'CERAD' in a promotional context, whilst CY7 shows it being used as part of a technical document setting out the criteria and qualifications required for a particular grade of ambulance practitioner.
  
18. Of the twenty-three exhibits provided by both the opponent and applicant combined, only six are clearly dated *prior* to the relevant date of 29 January 2021 (three from the opponent and three from the applicant). The other seventeen are either (i) dated after the relevant date, (ii) inconclusive (for example, by providing reference to the year 2021 without any further detail), or (iii) undated. It is also noted that whilst both parties have provided relatively few examples of the sign 'CERAD' being used in a commercial and/or promotional manner, much of what has been provided in that regard is duplicative. The opponent's exhibit NB10 consists of seven instances of 'CERAD' being used by seven different third parties, whilst the applicant's exhibit CY5 consists of eight showing similar types of use. Four of these exhibits are common to both parties' evidence. In the opponent's case, they have been presented in support of the claim that 'CERAD' is commonly used

by other traders and so is devoid of any distinctiveness. In the applicant's case, those exact same materials are used to support its claim that the sign is used by third party training providers in order to denote commercial origin. I shall consider the relative merits of both parties' evidence in further detail below when determining the primary question of whether, at the relevant date, the sign applied for was distinctive for the services claimed in class 41. Nevertheless, I should say at this point that I consider both parties' evidence to be of limited value.

### **Registrar's practice in relation to acronyms (and relevance to this decision)**

19. The Registrar's practice regarding *ex officio* examination of signs consisting of acronyms is published in the 'Examination Guide' section of the Manual of Trade Marks Practice. Under the heading '*Abbreviations, acronyms or initials*', the following is stated:

*"Trade marks consisting of abbreviations, acronyms or initials will be accepted unless research indicates that the letters represent descriptive words used in trade to denote the goods and/or services intended for protection. For example ABS (Advanced Braking System) for braking systems, CAD (Computer Aided Design) for computer software, PMS (PreMenstrual Syndrome) for pharmaceutical products. In such cases an objection under section 3(1)(c) will be taken".*

20. In the context of *ex officio* examination, this practice places a duty on the examiner to undertake their own research in order to determine whether or not the acronym in question 'represents' descriptive words used in trade. It reflects the fact that acronyms are often also neologisms. As with the Examination Guide examples presented above, they are coined from the initial letters of other words that comprise a longer expression and, as a result, their meaning and function will often be limited to representing that longer expression and nothing more (although sometimes the resulting acronym can also be a recognisable word in its own right). As a consequence, the duty of an examiner assessing any acronym in an *ex officio* context is to undertake

research in order to determine whether or not that acronym is recognisable to, and understood by, the relevant public as being representative of a descriptive (or non-distinctive) expression.

21. In relation to the current *inter partes* proceedings, the context and the approach are different, but the objective is the same. Rather than undertake any research of my own, I shall consider the submissions and evidence submitted by both parties and decide whether or not those materials show that, at the relevant date, the sign 'CERAD' was understood by the relevant consumer as representing words that are descriptive and/or non-distinctive when used in relation to the Class 41 services intended for protection.

## Legislation

22. The relevant parts of section 3(1) of the Act are as follows:

“The following shall not be registered -

...

(b) trade marks which are devoid of any distinctive character,

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

...

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

23. These grounds are independent and have different general interests. It is possible for a mark not to fall foul of section 3(1)(c) but still be objectionable under section 3(1)(b): see *SAT.1 SatellitenFernsehen GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case C-392/02 P, paragraph 25<sup>2</sup>. However, where a mark is descriptive of the goods or services for which it is registered, it necessarily lacks the required distinctiveness to avoid objection under section 3(1)(b). I shall therefore begin by considering the section 3(1)(c) ground.

### **Section 3(1)(c)**

24. The case law under section 3(1)(c) (corresponding to Article 7(1)(c) of the EUTM Regulation, formerly Article 7(1)(c) of the CTM Regulation) was set out by Arnold J (as he then was) in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch) as follows:

“91. The principles to be applied under art. 7(1)(c) of the CTM Regulation were conveniently summarised by the CJEU in *Agencja Wydawnicza Technopol sp. z o.o. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-51/10 P) [2011] E.T.M.R. 34 as follows:

‘33. A sign which, in relation to the goods or services for which its registration as a mark is applied for, has descriptive character for the purposes of Article 7(1)(c) of Regulation No 40/94 is – save where Article 7(3) applies – devoid of any distinctive character as regards those goods or services (as regards Article 3 of First Council Directive 89/104/EEC of 21 December

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<sup>2</sup> Section 6(3)(a) of the European (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to refer to the trade mark case-law of EU courts, although the UK has left the EU.

1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L40, p. 1), see, by analogy, [2004] ECR I-1669, paragraph 19; as regards Article 7 of Regulation No 40/94, see *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr & Co* (C-191/01 P) [2004] 1 W.L.R. 1728 [2003] E.C.R. I-12447; [2004] E.T.M.R. 9; [2004] R.P.C. 18, paragraph 30, and the order in *Streamserve v OHIM* (C-150/02 P) [2004] E.C.R. I-1461, paragraph 24).

36. ...due account must be taken of the objective pursued by Article 7(1)(c) of Regulation No 40/94. Each of the grounds for refusal listed in Article 7(1) must be interpreted in the light of the general interest underlying it (see, inter alia, *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-456/01 P) [2004] E.C.R. I-5089; [2005] E.T.M.R. 44, paragraph 45, and *Lego Juris v OHIM* (C-48/09 P), paragraph 43).

37. The general interest underlying Article 7(1)(c) of Regulation No 40/94 is that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services (see, to that effect, *OHIM v Wrigley*, paragraph 31 and the case-law cited).

38. With a view to ensuring that that objective of free use is fully met, the Court has stated that, in order for OHIM to refuse to register a sign on the basis of Article 7(1)(c) of Regulation No 40/94, it is not

necessary that the sign in question actually be in use at the time of the application in a way that is descriptive. It is sufficient that the sign could be used for such purposes (*OHIM v Wrigley*, paragraph 32; *Campina Melkunie*, paragraph 38; and the order of 5 February 2010 in *Mergel and Others v OHIM* (C-80/09 P), paragraph 37).

39. By the same token, the Court has stated that the application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question (Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] E.C.R. I-2779, paragraph 35, and Case C-363/99 *Koninklijke KPN Nederland* [2004] E.C.R. I-1619, paragraph 38). It is, furthermore, irrelevant whether there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration (*Koninklijke KPN Nederland*, paragraph 57).

And

46. As was pointed out in paragraph 33 above, the descriptive signs referred to in Article 7(1)(c) of Regulation No 40/94 are also devoid of any distinctive character for the purposes of Article 7(1)(b) of that regulation. Conversely, a sign may be devoid of distinctive character for the purposes of Article 7(1)(b) for reasons other than the fact that it may be descriptive (see, with regard to the identical provision

laid down in Article 3 of Directive 89/104, *Koninklijke KPN Nederland*, paragraph 86, and *Campina Melkunie*, paragraph 19).

47. There is therefore a measure of overlap between the scope of Article 7(1)(b) of Regulation No 40/94 and the scope of Article 7(1)(c) of that regulation (see, by analogy, *Koninklijke KPN Nederland*, paragraph 67), Article 7(1)(b) being distinguished from Article 7(1)(c) in that it covers all the circumstances in which a sign is not capable of distinguishing the goods or services of one undertaking from those of other undertakings.

48. In those circumstances, it is important for the correct application of Article 7(1) of Regulation No 40/94 to ensure that the ground for refusal set out in Article 7(1)(c) of that regulation duly continues to be applied only to the situations specifically covered by that ground for refusal.

49. The situations specifically covered by Article 7(1)(c) of Regulation No 40/94 are those in which the sign in respect of which registration as a mark is sought is capable of designating a 'characteristic' of the goods or services referred to in the application. By using, in Article 7(1)(c) of Regulation No 40/94, the terms 'the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service', the legislature made it clear, first, that the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the

service must all be regarded as characteristics of goods or services and, secondly, that that list is not exhaustive, since any other characteristics of goods or services may also be taken into account.

50. The fact that the legislature chose to use the word 'characteristic' highlights the fact that the signs referred to in Article 7(1)(c) of Regulation No 40/94 are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. As the Court has pointed out, a sign can be refused registration on the basis of Article 7(1)(c) of Regulation No 40/94 only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics (see, by analogy, as regards the identical provision laid down in Article 3 of Directive 89/104, *Windsurfing Chiemsee*, paragraph 31, and *Koninklijke KPN Nederland*, paragraph 56).'

92. In addition, a sign is caught by the exclusion from registration in art.7(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned: see *OHIM v Wrigley* [2003] E.C.R. I-12447 at [32] and *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (C-363/99) [2004] E.C.R. I-1619; [2004] E.T.M.R. 57 at [97]."

### **Relevant consumer**

25. When considering how the sign will be perceived in use, I take into account the perspective of the average consumer, who is deemed to be reasonably

observant and circumspect<sup>3</sup>. At the hearing before me, the opponent claimed that the average consumer in this case is both a training provider (i.e. a business) and a member of the general public looking to source and receive particular training (e.g. an individual who seeks a career in emergency response and/or ambulance driving, and who understands the professional requirements for such a role). In both scenarios, the opponent submitted that attention levels would be average. In contrast, the applicant referred to the now much-reduced class 41 specification as support for its position that the average consumer would be more specialist and operating from within a professional sector (such as a training provider or a regulatory body). Although not expressly stated at the hearing, I infer from this that the applicant believes attention levels would be higher than average.

26. In my view, limitation of the specification to the seven particular services listed at paragraph 11 above largely supports the applicant's position. Bodies with responsibility for developing qualifications and standards (whether academic or vocational) are more likely to operate within specialist educational and professional sectors, rather than face the general public. The applicant's claim is for services provided to training providers, rather than to individuals seeking vocational training. In this type of scenario, I would expect the customer to pay a higher degree of attention (but not the highest) on the basis that they would want to ensure the services they provide (e.g. their training courses) are recognisable and accredited in a way that makes them attractive and valuable to a potential trainee. Therefore, I conclude that the average consumer is likely to be specialist rather than general, and would apply a higher than average degree of attention.
27. Whilst the assessment of distinctive character that follows is premised on these findings regarding the relevant consumer and corresponding attention levels, I should say that I do not consider such factors to be heavily determinative on the overall outcome. Given its nature as a five-letter invented word (which, on the basis of evidence, may or may not be found to represent

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<sup>3</sup> *Matratzen Concord AG v Hukla Germany SA*, Case C-421/04

a longer descriptive expression), I consider the average consumer's ability to identify inherent distinctiveness to be relatively unaffected by attention levels engaged at the point of sale. The extent to which the evidence does or does not show that said average consumer recognises the sign as being representative of a longer expression is much more relevant.

### **Relevance and consideration of the expression 'Certificate in Emergency Response Ambulance Driving'**

28. The opponent's case in respect of the sign 'CERAD', as presented in both its skeleton argument and oral submissions, was premised on a starting assumption that the expression 'Certificate in Emergency Response Ambulance Driving' is recognised and understood as being descriptive of, and non-distinctive for, the services claimed. At the hearing, and as a secondary argument behind its primary submissions regarding the requirement for my assessment to be based on evidence, the applicant challenged the opponent's starting assumption by claiming that the nature of its services - being *related to* training rather than training *per se* - meant that the expression 'Certificate in Emergency Response Ambulance Driving' is not descriptive.
  
29. Whilst my key assessment must be in relation to the sign 'CERAD', rather than to the longer expression it may or may not be intended to denote, it is necessary to consider the longer expression as a preliminary matter. Notwithstanding the applicant's submissions, I am not persuaded that the expression 'Certificate in Emergency Response Ambulance Driving' - if that were the sign under consideration - is inherently distinctive for the services claimed. In accordance with the opponent's submissions, the phrase itself clearly describes a qualification, award, achievement or status relating to the activity of ambulance driving in the context of providing an emergency response. I accept that it may not literally or directly describe the development of professional qualifications or standards or the awarding of certificates, but it is a key component in the provision of such services. In reaching this view, I bear in mind the opponent's reference to Case O/240/02 '*Fourneaux De*

*France*’ wherein the Appointed Person, assessing a French-language phrase which translates literally as meaning ‘Cookers from France’, considered the extent to which that sign’s capacity to describe goods intended for protection extended beyond cookers, ovens and hobs into complementary items such as cooker hoods and extractors. In that case, the Appointed Person described the latter items as being “*closely connected items of commerce*” and found descriptiveness “*at a high level of generality*” to the extent that any distinction between directly described terms and those which are closely connected was artificial. I consider the same to apply here. The full expression ‘Certificate in Emergency Response Ambulance Driving’ literally describes *both* a standard or level of achievement *and* a physical document produced and awarded in relation to that achievement. Where it is the case that, in the broadest context of the applicant’s services, a proficiency level, status and/or physical certificate is ultimately awarded to a trainee, I do not believe the relevant consumer would, without being educated to the fact, perceive the expression as being an indicator of commercial origin. It would be understood as describing the artefact awarded on completion of the training activity, regardless of any actual distinction between the party developing the qualification and the party providing the training.

30. Having concluded that the expression ‘Certificate in Emergency Response Ambulance Driving’ is descriptive of, and therefore devoid of any distinctive character in relation to, the applicant’s services, I must now consider the more salient question of whether the sign applied for i.e. ‘CERAD’ is distinctive for the services claimed.

### **Assessment of the sign**

31. In its written and oral submissions, the opponent referred to established caselaw relating to neologisms including *Leonard & Ellis’s Trade Mark* ((1884) 26 Ch D 288 ‘Vaseline’), *McCain International Ltd v Country Fair Foods Ltd* ((1981) RPC 69 ‘Oven Chips’) and *Wirex Ltd v Cryptocarbon Global Ltd* ([2021] EWHC 617 (IPEC) ‘Cryptoback’). These were presented in support of the opponent’s submission that the invention of a new term does not preclude

it *per se* from also having the inherent capacity to describe the goods or services it is used in relation to. Whilst I accept this as a general principle, I also note that outside of reliance on its evidence, the opponent has failed to provide any reasons as to why the sign 'CERAD' should be deemed apt to describe the services claimed. There is nothing to indicate that it has any wider or general meaning or significance (such as e.g. dictionary definitions or internet references). Considered in the *prima facie* case, it consists of an arbitrary but pronounceable sequence of five letters 'C-E-R-A-D'. Unlike a term such as 'Oven Chips', the resulting sign 'CERAD' has no immediate apparent connection with the services claimed. In reaching this view, I bear in mind Zacaroli J's decision in *Puma SE v Nike Innovate C.V.* [2021] EWHC 1438 (CH) where, at paragraph 21, the following was stated:

“Ultimately, as Ms Himsworth QC submitted, the question is whether the mark applied for, when notionally and fairly used, is descriptive of the goods and services in question within the meaning of section 3(1)(c). A sign can be refused registration ‘only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of [the characteristics in section 3(1)(c)]’: *Technopol* (above), at [50]. Moreover, a sign will be descriptive ‘if there is a sufficiently direct and specific relationship between the sign and the goods and services in question to enable the public concerned immediately to perceive, without further thought, a description of one of the characteristics of the goods and services in question’: *Case T-234/06 Giampetro Torresan* (above) at [25].”

32. As far as the opponent's submissions are concerned, I see nothing that directs me away from treating the sign as a wholly invented term which - depending on what is shown by the evidence filed - may or may not be perceived by the relevant public as an acronym denoting the (descriptive) expression 'Certificate in Emergency Response Ambulance Driving'.
33. The applicant disputes the relevance of established caselaw relating to neologisms on the basis that the quoted cases applied to scenarios in which a

word or expression was created with the intention of being an apt descriptor of a *newly conceived* good or service. The applicant emphasises that its own Class 41 services do not fall into this category; in its skeleton argument, it describes the mark as being “...*just a brand name being applied to a product/service in the normal way*”. Having emphasised that any assessment of the sign should not be limited to considering its merits as a neologism, the applicant’s submissions focus on the necessity for any assessment of descriptiveness and/or non-distinctiveness to be based solely on facts gleaned from the evidence submitted.

34. I agree with the applicant on this approach. As indicated at paragraph 31 above, I have nothing from either party indicating that the sign ‘CERAD’ has any inherent meaning in relation to the services claimed. What I do have is submissions from the opponent alleging that the sign is both descriptive and non-distinctive on account of its common usage as an acronym for the descriptive expression ‘Certificate in Emergency Response Ambulance Driving’, by more than one provider, and to the extent that it is recognisable amongst relevant consumers as being an origin-neutral sign. As a result, my assessment must be purely factual. If the evidence fails to support the opponent’s claim because it does *not* show that ‘CERAD’ is a descriptive and/or non-distinctive term, then the opposition under sections 3(1)(b) and (c) will also fail. If, on the other hand, the opponent’s evidence *does* show that, at the relevant date, the sign ‘CERAD’ was recognisable amongst the relevant public as an acronym for the phrase ‘Certificate in Emergency Response Ambulance Driving’, then I would conclude that the sign is descriptive and devoid of any distinctive character.

### **Impact of Opponent’s evidence**

35. I return to my consideration of the opponent’s evidence (as summarised at paragraphs 13-15 above). Whilst Mr Barraclough’s statement claims that his accompanying exhibits show the sign ‘CERAD’ being used as an acronym, the reality is that most of them fail to show use of the sign to any extent. Four of the ten exhibits consist of job descriptions for ambulance and emergency

roles as published on specialist websites, whilst a further three consist of corresponding 'Assessment Plans' setting out minimum qualification requirements etc. (see Exhibits NB1, NB2, NB3, NB6, NB7, NB8 and NB9). All but one of these seven exhibits fail to present the sign 'CERAD' to any extent. Some include terms such as 'Certificate in Emergency Response Driving', 'Level 3 Emergency Response Driving' and 'Level 3 Certificate in Emergency Response Driving', but - apart from recognising the similarity between those terms and the 'expanded' term alleged to be represented by the acronym - these references add little weight to the opponent's case.

36. Only two of the ten exhibits - NB3 and NB10 - actually show use of the mark applied for. The 'Assessment Plan' submitted as NB3 includes a pie chart diagram labelled 'CERAD' that is presented in reasonable proximity to the phrase 'Level 3 Emergency Response Driving' which appears on the preceding page (the phrase 'Certificate in Emergency Response Ambulance Driving' is not visible anywhere in the document). NB10 consists of seven examples of third-party promotional use, four of which present 'CERAD' in very close proximity to the expressions 'Certificate in Emergency Response Driving' and 'Emergency Response Ambulance Drivers' (the other three present 'CERAD' but without any indication as to its possible meaning)
37. With none of the opponent's additional five exhibits submitted as evidence-in-reply presenting any use of 'CERAD', my factual assessment of the sign's alleged significance, meaning and function as an acronym for 'Certificate in Emergency Response Ambulance Driving' is limited to exhibits NB3 and NB10. NB10 makes the strongest case, given that - as confirmed in the previous paragraph - four of its seven examples *do* show both the sign and the expanded term in close proximity to each other. NB3 presents the sign applied for, plus a reference to a variation on the expanded term (not the expanded term itself) on a previous page.
38. Even if I were to give no consideration to the relevant date (which I do), these two exhibits alone would not be enough to show that the sign 'CERAD' is recognised as representing descriptive words. When I take into account the

relevant date of 29 January 2021 and consider the dates of materials submitted, I find little to strengthen the opponent's case. Exhibit NB3, which presents the sign 'CERAD' *without* a corresponding reference to 'Certificate in Emergency Response Ambulance Driving' includes a Crown Copyright date of 2018. Exhibit NB10, which includes the only four examples that *do* show the sign 'CERAD' being used in close proximity to the longer expression 'Certificate in Emergency Response Ambulance Driving' are all undated. All other exhibits are either undated or, in the case of Exhibits NB1, NB6, NB8 and NB9, inconclusive to the extent they include content which may or may not have been published prior to the relevant date (they include references to 'version logs' quoting years both prior to and after the relevant date). In all cases, these inconclusively dated exhibits do no more than demonstrate that the expressions 'Certificate in Emergency Response Ambulance Driving' and 'Certificate in Emergency Response Driving' were in use. They have very limited value in terms of demonstrating that 'CERAD' was being used as an acronym and recognised as such by the relevant public.

39. In conclusion, the opponent's evidence largely serves to confirm that phrases such as 'Level 3 Certificate in Emergency Response Driving' and 'Level 3 Certificate in Emergency Response Ambulance Driving' have been used, at some point in the past, by various parties connected with the provision of training and standards in emergency response services. There is little evidence of the applied-for sign 'CERAD' being used, and even less to indicate that it has been used in a way which is synonymous with, or connected to, the descriptive expression 'Certificate in Emergency Response Ambulance Driving'. And in the one instance where such use is shown - i.e. four examples included as part of Exhibit NB10 - the references are undated.
40. The test before me is to determine whether or not, at the relevant date of 29 January 2021, and based upon the evidence submitted, the sign 'CERAD' was descriptive of the services claimed because of its capacity to be recognised and understood as an abbreviated form of the longer expression 'Certificate in Emergency Response Ambulance Driving'. For the reasons given above, the opponent's evidence fails to show that this was the

case. As a result, I must conclude that - at the relevant date on which the application was filed - the sign possessed the requisite amount of inherent distinctive character.

### **Section 3(1)(b)**

41. The principles to be applied under Article 7(1)(b) of the CTM Regulation (which is now Article 7(1)(b) of the EUTM Regulation, and is identical to Article 3(1)(b) of the Trade Marks Directive and section 3(1)(b) of the Act) were conveniently summarised by the CJEU in *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG*, Case C-265/09 P, as follows:

“29. ...the fact that a sign is, in general, capable of constituting a trade mark does not mean that the sign necessarily has distinctive character for the purposes of Article 7(1)(b) of the regulation in relation to a specific product or service (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 32).

30. Under that provision, marks which are devoid of any distinctive character are not to be registered.

31. According to settled case-law, for a trade mark to possess distinctive character for the purposes of that provision, it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings (*Henkel v OHIM*, paragraph 34; Case C-304/06 P *Eurohypo v OHIM* [2008] ECR I-3297, paragraph 66; and Case C-398/08 P *Audi v OHIM* [2010] ECR I-0000, paragraph 33).

32. It is settled case-law that that distinctive character must be assessed, first, by reference to the goods or services in respect of

which registration has been applied for and, second, by reference to the perception of them by the relevant public (*Storck v OHIM*, paragraph 25; *Henkel v OHIM*, paragraph 35; and *Eurohypo v OHIM*, paragraph 67). Furthermore, the Court has held, as OHIM points out in its appeal, that that method of assessment is also applicable to an analysis of the distinctive character of signs consisting solely of a colour per se, three-dimensional marks and slogans (see, to that effect, respectively, Case C-447/02 P *KWS Saat v OHIM* [2004] ECR I-10107, paragraph 78; *Storck v OHIM*, paragraph 26; and *Audi v OHIM*, paragraphs 35 and 36).

33. However, while the criteria for the assessment of distinctive character are the same for different categories of marks, it may be that, for the purposes of applying those criteria, the relevant public's perception is not necessarily the same in relation to each of those categories and it could therefore prove more difficult to establish distinctiveness in relation to marks of certain categories as compared with marks of other categories (see Joined Cases C-473/01 P and C-474/01 P *Procter & Gamble v OHIM* [2004] ECR I-5173, paragraph 36; Case C-64/02 P *OHIM v Erpo Möbelwerk* [2004] ECR I-10031, paragraph 34; *Henkel v OHIM*, paragraphs 36 and 38; and *Audi v OHIM*, paragraph 37)."

42. A trade mark may therefore fall foul of section 3(1)(b) of the Act for reasons other than its descriptive qualities. However, the applicant's case under this section also relies on the alleged descriptiveness of the contested mark and it presents no other reasons why it claims the mark is devoid of any distinctive character. Therefore, the section 3(1)(b) ground also fails.

## **Conclusion**

43. Had I found that the opponent's evidence supported its claim that the sign was, at the relevant date, recognised amongst relevant consumers as being representative of the expression 'Certificate in Emergency Response

Ambulance Driving’, then I would also be required to consider the extent to which the applicant’s evidence demonstrates distinctiveness acquired through use. However, because I have found the evidence does *not* support the opponent’s claim, the sign must be deemed to be inherently distinctive. Therefore, any further consideration of acquired distinctiveness is redundant and unnecessary.

44. In light of my findings regarding the evidence, I conclude that the opposition fails in respect of the section 3(1)(b) and (c) grounds. With the original decision having already found that the section 3(1)(d) ground fails (and that point not being subject to the Appointed Person’s order remitting the case back to the Registrar for further consideration), this means that the opposition fails in its entirety. Therefore, and subject to the applicant filing a Form TM21B, the trade mark will now proceed to registration for the following (revised) specification:

Class 41      Development of qualifications, standards, approval of training providers, quality assurance of training providers, awarding of certificates, assessment and certification services, all relating to the training of paramedics and ambulance personnel.

45. Because this decision is subject to the recordal of specification amendments, under Rule 62(1) of the Trade Marks Rules 2008 I direct that the applicant file a Form TM21B requesting deletion of Classes 09 and 16 and amendment of Class 41 to the terms shown above, within a period of fourteen days from the date of this decision.

### **Costs**

46. As the applicant has been successful, it is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 1/2023. I also take note of the fact that in his related order dated 6 November 2022, the Appointed Person directed that the Respondent (i.e. the opponent) pay the

Appellant (i.e. the applicant) a contribution of £1,000 towards its costs. I treat these particular costs as being specifically associated with the appeal to the Appointed Person.

47. Therefore, in calculating an overall award to the applicant, I am required to take into account (i) costs associated with Tribunal proceedings that led to the original decision, (ii) costs associated with the appeal (where the amount of £1000 has already been specified in the Appointed Person's order), and (iii) costs associated with the second hearing following remittal back to the Registrar. The final sum is calculated as follows:

Considering the notice of opposition and preparing a counterstatement	£250
Preparing evidence and considering the opponent's evidence	£600
Preparing for and attending the original hearing	£800
Preparing for and attending the appeal hearing before the Appointed Person	£1000
Preparing for and attending the second hearing following remittal back to the Registrar	£800
<b>Total</b>	<b>£3450</b>

48. I order Qualsafe Limited to pay Future (Awards and Qualifications) Limited the sum of £3450. This sum is to be paid within twenty-one days of the expiry of the appeal period, or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 28th day of September 2023**

**Nathan Abraham  
For the Registrar,  
The Comptroller-General**